Lee Jin Jong (sole proprietor and t/a Jing Mi Enterprise) v Boon Wai Leong (t/a Fire Sandwood Enterprise) & Anor

HIGH COURT (JOHOR BAHRU) — SUIT NO 22IP-7–07 OF 2014
TEO SAY ENG J
7 APRIL 2016

Trade Marks — Infringement of — Registered trademark and passing off — Similar marks used for Chinese prayer materials — Likelihood of confusion or deception — General recollection test — Principles applicable in establishing likelihood of confusion and deception — Whether trademarks identical — Whether distinctive features existed in both marks — Whether plaintiff claim exclusive use of picture and words which appears commonly in almost all Chinese praying materials — Whether acts of infringement of trademark and passing off proven — Trade Marks Act 1976 s 38(1)

The plaintiff and the defendants were engaged in the trade of distributing and selling Chinese praying materials, religious supplies and and Feng Shui merchandise. The plaintiff manufactured, distributed and sold a product used in Chinese prayers called Cai Shen Jin Yu Mi ('CSJYM'). The plaintiff had registered the name of the product and the artwork of the set up as his registered trademark on 27 December 2005 and was at all material times valid and subsisting throughout Malaysia. The registered trademark consisted of a Chinese-style painting. Since around 2000, the plaintiff had attained substantial sales, due in part to the promotions and advertisements of the plaintiff's goods in Malaysia. By virtue of such substantial sales, promotions and advertisements, the plaintiff had acquired substantial reputation in the plaintiff's mark and the plaintiff's get-up. The public had as a result of such extensive sales, promotions and advertisements, come to associate the plaintiff's get-up with the plaintiff and with no other party. The plaintiff claimed that since around 2012 the defendants had without the consent of the plaintiff, manufactured and sold Chinese praying materials, religious supplies and Feng Shui merchandise bearing a colourably, audibly and deceptively similar trademark and get-up to that of the plaintiff's mark and the plaintiff's get-up. The plaintiff thus claimed that the defendants had infringed the plaintiff's mark and passed off their goods as and for that of the plaintiff. The plaintiff prayed for injunctive and other reliefs against the defendants.

Held, dismissing the plaintiff's claim with cost of RM30,000:

(1) In determining whether a registered trademark is infringed by a person who uses a mark which is identical with it or so nearly resembling it as is likely to deceive or cause confusion in the course of trade as envisaged in

s 38(1) of the Trade Marks Act 1976, the courts have applied the general recollection test adopted by the then Lord President Thompson in the case of *Re Sandow Ltd's Application* in *MI & M Corporation & Anor v A Mohamed Ibrahim* [1964] 3 MLJ 392 (see para 14(c)(i)(1)).

(2) The two trademarks were not identical. The only resemblances in the two marks were: (a) the use of the pictures the god of fortune, two fairy maidens and some children; and (b) the use of some same Chinese words to describe their respective products, namely the plaintiff's registered product was called 'Cai Shen Jin Yu Mi' whereas the defendants' infringing product was called 'Cai Shen Chao Cai Jin Yu Mi'. However there were some distinctive features of the two respective marks (see para 14(c)(ii)).

(3) In applying the general recollection test whether a consumer who sees the defendant's trade mark in the absence the plaintiff's registered trademark and in view only of his general recollection of what the nature of the plaintiff's trademark was, would be liable to be deceived and to think that the defendants' trademark before him is the same as the other, of which he has a general recollection, it is not sufficient for the court to consider the sound and look of the two opposing marks but to also consider all the surrounding factors and features of the two trademarks (see para 14(c)(iv)).

(4) Applying the general recollection test on the evidence adduced and the two opposing trademarks tendered in court, the evidence adduced by the plaintiff vide the three consumers (PW4, PW5 and PW6) to prove likelihood of confusion was insufficient to show that defendants' mark was confusingly similar to that of the plaintiff. The test is an objective one (see para 14(c)(iv)).

(5) When a consumer were to see the defendants' trademark in the absence of the plaintiff's trademark, he would not be liable to be deceived and to think that the defendant's mark was the same as the plaintiff, of which he has a general recollection. As regards the picture of the God of Fortune and the two Fairy Maidens, the plaintiff could not claim exclusive use of the said picture as such pictures appear commonly in almost all praying materials in the Chinese community. Similarly the words 'Cai Shen' is the name of the God of Fortune who is commonly worshiped by the Chinese community. Further, that 'Jing Yu Mi' is the name of the product which the plaintiff could not have an exclusive use (see para 14(c)(v)).

(6) The plaintiff failed to prove the defendant's acts of infringement of the plaintiff's registered trademark and passing off (see para 15).

[Bahasa Malaysia summary

Plaintif dan defendan terlibat dalam perniagaan mengedar dan menjual barang-barang sembahyang, bekalan agama dan barangan Feng Shui. Plaintif mengilang, mengedar dan menjual produk yang digunakan dalam sembahyang orang Cina dipanggil 'Cai Shen Jin Yu Mi'. Plaintif telah mendaftarkan nama produk dan karya seni yang ditubuhkan sebagai cap dagangan yang didaftarkan pada 27 Disember 2005 dan pada setiap masa material adalah sah dan ada di seluruh Malaysia. Cap dagangan berdaftar mempunyai gaya lukisan Cina. Sejak sekitar tahun 2000, plaintif telah mendapat jualan yang substansial, disebabkan sebahagiannya oleh promosi dan pengiklanan barangan plaintif di Malaysia. Berdasarkan jualan substansial, promosi dan pengiklanan, plaintif telah memperoleh reputasi yang besar dalam cap plaintif dan *get-up* plaintif. Orang awam juga telah, disebabkan jualan meluas, promosi dan iklan telah mengaitkan *get-up* plaintif dengan plaintif dan bukan dengan pihak lain. Plaintif mendakwa bahawa sejak sekitar tahun 2012 defendan-defendan telah, tanpa kebenaran plaintif, mengilang dan menjual bahan sembahyang Cina, bekalan sembahyang dan barangan Feng Shui yang mempunyai warna, letusan suara dan cap dagangan yang mengelirukan yang sama dan *get-up* yang menyerupai cap dan get-up plaintif. Plaintif oleh itu mendakwa bahawa defendan-defendan telah melanggar cap plaintif dan kelirupaan barangan mereka sebagai barangan plaintif. Plaintif memohon untuk injunksi dan relief-relief lain terhadap defendan-defendan.

Diputuskan, menolak tuntutan plaintif dengan kos RM30,000:

(1) Dalam menentukan sama ada cap dagang berdaftar telah dilanggar oleh seseorang yang menggunakan satu cap yang mana menyerupai dengannya atau hampir menyerupai sehingga mungkin memperdaya atau menyebabkan kekeliruan dalam urusan perdagangan sebagaimana termaktub dalam s 38(1) Akta Cap Dagangan 1976, mahkamah telah mengguna pakai ujian ingatan am yang diguna pakai oleh Lord President Thompson terdahulu dalam kes *Re Sandow Ltd's Application* ke atas *MI & M Corporation & Anor v A Mohamed Ibrahim* [1964] 3 MLJ 392 (lihat perenggan 14(c)(i)(1)).

(2) Kedua-dua cap dagang adalah tidak serupa. Persamaan yang ada dalam kedua-dua cap adalah (a) penggunaan gambar 'god of fortune', dua bidadari dan beberapa orang kanak-kanak dan (b) penggunaan beberapa perkataan Cina yang sama yang menerangkan produk masing-masing, iaitu produk berdaftar plaintif dipanggil 'Cai Shen Jin Yu Mi' manakala produk defendan-defendan dipanggil 'Cai Shen Chao Cai Jin Yu Mi. Walau bagaimanapun terdapat ciri-ciri yang tersendiri pada kedua-dua cap masing-masing (lihat perenggan 14(c)(ii)).

(3) Dalam menggunakan ujian ingatan am sama ada pengguna yang melihat cap dagangan defendan-defendan dalam ketiadaan cap dagangan plaintif

dan berdasarkan ingatan amnya akan jenis cap dagangan plaintif, akan menjadi bertanggungan untuk memperdaya dan untuk memikirkan bahawa cap dagangan defendan-defendan di hadapannya adalah sama seperti yang lain, yang mana dia mempunyai ingatan am, adalah tidak mencukupi bagi mahkamah untuk mempertimbangkan akan bunyi dan rupa dua cap berbeza tetapi juga untuk mempertimbangkan faktor dan ciri-ciri sekeliling kedua-dua cap dagangan (lihat perenggan 14(c)(iv)).

(4) Mengguna pakai ujian ingatan am terhadap keterangan yang dikemukakan dan kedua-dua cap dagangan yang dikemukakan di mahkamah, keterangan yang dikemukakan oleh plaintif melalui tiga pengguna (PW4, PW5 dan PW6) untuk membuktikan kemungkinan kekeliruan adalah tidak mencukupi untuk menunjukkan cap defendan-defendan adalah sama sehingga mengelirukan cap plaintif. Ujian itu adalah satu ujian yang mempunyai objektif (lihat perenggan 14(c)(iv)).

(5) Apabila seorang pengguna melihat cap dagang defendan dalam ketiadaan cap dagangan plaintif, dia tidak akan bertanggungan kerana tertipu dan kerana memikirkan bahawa cap defendan-defendan adalah sama seperti plaintif yang mana dia mempunyai ingatan am. Berkaitan dengan gambar 'god of fortune' dan dua bidadari, plaintif tidak boleh menuntut penggunaan ekslusif atas gambar tersebut kerana gambar itu kelihatan umum dalam hampir semua bahan sembahyang dalam komuniti Cina. Begitu juga dengan perkataan 'Cai Shen' yang merupakan nama 'god of fortune' yang secara umum disembah oleh komuniti Cina. Selanjutnya, 'Jin Yu Mi' itu adalah nama produk yang mana plaintif tidak boleh mempunyai penggunaan ekslusif (lihat perenggan 14(c)(v)).

(6) Plaintif gagal membuktikan perbuatan pelanggaran defendan-defendan terhadap cap dagangan plaintif dan kelirupaan (lihat perenggan 15).]

Notes

For cases on registered trademark and passing off, see 12(2) *Mallal's Digest* (5th Ed, 2015) paras 2686–2706.

Cases referred to

Bailey's Application, Re [1935] 52 RPC 136, Ch D (refd)

Bata Ltd v Sim Ah Ba @ Sim Teng Khor & Ors (trading as Kheng Aik Trading) [2006] 6 MLJ 445; [2006] 1 MLRA 762, CA (refd)

Brg Brilliant Rubber Goods (M) Sdn Bhd v Santa Barbara Polo & Racquet Club Management Inc (Pendaftar Cap Dagang Malaysia, pihak berkepentingan) [2015] 1 MLRHU 1, HC (refd)

Broadhead's Application, Re [1950] 67 RPC 113, Ch D (refd)

Kidax (Shirts) Ltd's Applications, Re [1959] RPC 295, Ch D (refd)

Meidi-Ya Co Ltd, Japan & Anor v Meidi (M) Sdn Bhd [2009] 2 MLJ 14; [2008] 3 MLRA 80, FC (refd)
MI & M Corporation & Anor v A Mohamed Ibrahim [1964] 3 MLJ 392, FC (refd)
Pianotist Co's Application, Re [1906] 23 RPC 774, Ch D (refd)
Rotta Research Laboratorium SPA & Anor v Ho Tack Sien & Ors (Chai Yuet Ying, third party) [2015] 4 MLJevi 222; [2011] 6 MLRH 584, HC (refd)
Sandow Ltd's Application, Re (1914) 31 RPC 196, Ch D (refd)
Saville Perfumery Ltd v June Perfect Ltd and Woolworth & Co Ltd (1941) 58 RPC 149, HL (refd)
Tan Hap & Anor v Liang Ann Hock [1989] 2 CLJ 500, HC (refd)
Tohtonku Sdn Bhd v Superrace (M) Sdn Bhd [1992] 2 MLJ 63; [1992] 1 MLRA 350, SC (refd)

Legislation referred to

Trade Marks Act 1976 s 38(1)

Harleen Leena Kaur (Lim Soo Wen with her) (Michael Chai Ken & Co) for the plaintiff.
Ungku Ahmad Hafis bin Ungku Fathil (Siti Maznah Mariam Mokhtar with him) (Chiong & Partners) for the defendants.

Teo Say Eng J:

THE PLAINTIFF'S CASE

[1] The plaintiff is an individual citizen of Malaysia and the sole proprietor of a business known as Jing Mi Enterprise (business registration No JM0425585-V) with a business address at No 11, Jalan Hang Kasturi 6, Taman Skudai Baru, 81300 Skudai, Johor. The plaintiff is and was at all material times engaged in the trade of distributing and selling Chinese praying materials, religious supplies and and Feng Shui merchandise in Malaysia. Jing Mi Enterprise is the exclusive distributor of its own products in Malaysia.

[2] The defendants are individual citizens of Malaysia and are partners in a business known as Fire Sandwood Enterprise (business registration No JM06251090A) with a business address No 31, Jalan Melawati 16, Taman Melawati, 81300 Skudai, Johor. The defendants are and were at all material times engaged in the trade of distributing and selling Chinese praying materials, religious supplies and Feng Shui merchandise in Malaysia.

[3] The plaintiff's mark:

(a) the plaintiff is a businessman who claims that he manufactures, distributes and sells a product which is used in Chinese prayers called Cai Shen Jin Yu Mi ('CSJYM'); and

(b) the plaintiff had registered the name of the product and the artwork of the set up as his registered trademark on 27 December 2005 and was at all material times valid and subsisting throughout Malaysia. The registered trade mark consists of a Chinese-style painting with a light yellow background, of a man with typical long ago/historical Chinese facial features and with long straight hair, long beard and long moustache, standing in the middle, facing to the left, wearing a red and blue imperial robe and Chinese scholar's hat, holding a stick in one hand along his arm; two women with typical long ago/historical Chinese features such as pale complexions in flowing ancient/historical robes and tall hair buns, standing next to the Chinese man — the woman on the right is holding a plate of fruits; and four children at the forefront in ancient/historical clothing standing in front of the Chinese man — two of the children in Chinese ponytails, carrying a basket of goods, heads facing each other, in respect of Chinese praying materials.

[4] Since around the year 2000, the plaintiff has attained substantial sales, due in part to the promotions and advertisements of the plaintiff's goods in Malaysia. Full particulars of such sales, advertisements and promotions will be adduced and furnished at trial.

By virtue of such substantial sales, promotions and advertisements, the plaintiff has acquired substantial reputation in the plaintiff's mark and the plaintiff's get-up and is therefore entitled to exclusive use of the same in Malaysia to the exclusion of all other parties.

[5] The public has as a result of such extensive sales, promotions and advertisements, come to associate the plaintiff's get-up with the plaintiff and with no other party.

[6] Since around the year 2012, the defendants have, without the consent, approval or authority of the plaintiff, manufactured distributed, offered for sale and sold Chinese praying materials, religious supplies and Feng Shui merchandise bearing a colourably, audibly and deceptively similar trademark and get-up to that of the plaintiff's mark and the plaintiff's get-up.

By reason of the acts aforesaid, the defendants have infringed the plaintiff's mark and passed off their goods as and for that of the plaintiff.

[7] The infringing and offending Chinese praying materials bearing the

infringing mark are counterfeit products, not manufactured by or do not originate from the plaintiff. The infringing and offending Chinese praying materials are of inferior quality. Upon a visual inspection, the infringing and offending Chinese praying materials use gold dust not manufactured by the plaintiff. This is evident from the colour and texture of the product.

[8] The defendants are selling the infringing and offending Chinese praying material at a cheaper price than the plaintiff, thereby undercutting the plaintiff's business. The infringing and offending Chinese praying material is sold at RM5.80 (West Malaysia) and RM7.80 (East Malaysia) while the plaintiff's Chinese praying material is sold at RM7.80 (West Malaysia) and RM9.90 (East Malaysia).

[9] The defendants and/or their agents and/or their employees have approached the plaintiff's dealers and suppliers and informed them that the plaintiff's products are now sold via the infringing mark and get-up.

[10] The defendants' acts are also a dishonest device intended and calculated to steal the business of the plaintiff and to misappropriate the goodwill, reputation and commercial advantage of the plaintiff acquired hitherto.

[11] The defendants are seeking to mislead and confuse the public into the belief that the infringing and offending Chinese praying materials offered for sale by the defendants originate from or are in some way connected or associated with the plaintiff when no such connection or association exists.

As a result of the aforesaid acts of infringement and passing off, the plaintiffs have suffered or are likely to continue to suffer irreparable loss and damage as well as injury to their goodwill and reputation.

[12] The plaintiff prays for injunctive and other reliefs against the defendants on the grounds that the defendants have infringed upon and passed-off the plaintiff's registered trademark and its get-up ('the plaintiff's mark'), by manufacturing, distributing and selling Chinese prayer materials, religious supplies and Feng Shui merchandise bearing a colourably, audibly and deceptively similar trademark and get-up to that of the plaintiff's mark, without the plaintiff's consent.

THE DEFENDANT'S CASE

[13] The line of the defendants' defence is, inter alia, as follows:

(a) that the defendant have not infringed the plaintiffs' trademark;

(b) that the said trademark 'Cai Shen Jin Yu Mi' and the mark 'Cai Shen Zhao Cai Jin Yu Mi' are visually and phonetically different;

(c) there is no confusion or deception or a possibility of confusion or deception arising from the defendants' use of their mark;

(d) the defendants' marks were created independently, with its own labor costs and expense and stand different from plaintiff's mark at any time;

(e) that the customers were not deceived or confused as a result of their use of the defendants' mark; and

(f) in fact, there are other marks resembling the same mark as the plaintiffs already in the market prior to the plaintiff's registration of the said trademark.

ISSUES FOR DETERMINATIONS

[14] There are three main issues for determination, namely:

Whether the defendant's mark in their product 'Cai Shen Zhao Cai Jin Yu Mi' is so nearly resembling the plaintiff's registered trademark as to be likely to deceive or cause confusion in the trade?

(a) The plaintiff's submission:

(i) the plaintiff has adduced evidence vide PW1 that he is a businessman who manufactures, distributes and sells a product which is used in Chinese prayers called Cai Shen Jin Yu Mi ('CSJYM'). The name of his product and the artwork of the get-up are his registered trademarks. This was supported by the certificates of registration issued by MyIPO (Intellectual Property Corporation of Malaysia);

(ii) the plaintiff clearly did not permit the defendants to use its marks. The plaintiff further adduced evidence through PW1 that 'You can see that the defendants have done all that they could do to destroy me and my business. They created and packaged products confusingly similar to mine; they told people in my industry that my business was closed. The first defendant claimed that his knowledge came from my Master Pang. The defendants' acts are clearly intended and calculated to steal and misappropriate my goodwill, reputation and commercial advantage that my products, Jing Mi Hang have acquired';

(iii) PW1 also said: 'It is clear that not only the defendants wanted the infringing products to be similar to my products in appearance but also to

sound similar. My products are named 'Cai Shen Jin Yu Mu' whereas the infringing products sound similar to my products because the infringing products are named 'Cai Shen Zhao Cai Jin Yu Mi'. In fact, I noticed that in several shops that sold the Infringing Products, the price tag was strategically placed over the words 'Zhao Cai'. I believe that this was intentionally done to mislead customers into thinking that they were in fact purchasing my products';

(iv) the plaintiff contends that the plaintiff's evidence regarding the registration and ownership of the marks was not disputed by the defendants. Further, the Kuala Lumpur High Court granted the plaintiff a trade description order dated 10 February 2014. The granting of such an order is prima facie evidence that there was infringement under the Trade Marks Act 1976;

(v) the plaintiff submits that the question of whether a device used as a trademark so nearly resembles another as to be likely to deceive or cause confusion is a question of fact. The plaintiff cites the Federal Court case of *MI & M Corporation & Anor v A Mohamed Ibrahim* [1964] 3 MLJ 392 where the then Lord President Thompson adopted the general recollection test in the case of *Re Sandow Ltd's Application* which states that:

> ... the question is whether the person who sees the proposed Trade Mark in the absence of the other Trade Mark, and in view only of his general recollection of what the nature of the other Trade Mark was, would be liable to be deceived and to think that the Trade Mark before him is the same as the other, of which he has a general recollection.

(vi) the plaintiff also cites another case of *Tan Hap & Anor v Liang Ann Hock* [1989] 2 CLJ 500, where the comparison test was applied taking into account the following considerations:

(1) the marks must be considered as a whole as the true test on the totality of impression given both orally and visually is as to cause mistake, deception or confusion;

(2) in comparing the two trademarks, it must be also considered whether the marks suggest the same idea or lead to the goods being referred to by the same name; and

(3) where words of two trademarks are compared, they must be judged by their look and sound.

(vii) the plaintiff submits that the answers to the test are factual, and are to be perceived by both sight and sound. The plaintiff has proved, by way of witness testimonies namely PW4, PW5 and PW6 that the defendants' mark is confusingly similar so as to cause misrepresentation. The first defendant admitted during cross-examination that the products are commonly referred to simply as Jing Yu Mi, and clearly the names are alike. Thus, all the above questions have been answered and the test is satisfied. There is clearly an act of infringement;

(viii) First In Use

During cross-examination of the plaintiff, DW1 suggested that the defendants were the first to use the name Cai Shen Zhao Cai Jin Yu Mi ('CSZCJYM'). This suggestion is refuted on the basis that during cross-examination of the plaintiff, the following evidence was given:

(1) in 1999, the plaintiff had commenced trading and selling his CSJYM product. Thus, the plaintiff was the first to use the invented name CSJYM;

(2) in response to a question from the defence counsel, the plaintiff replied that photos of his product in 1999, with the artwork, is at pp 36–38 of Bundle B1. This evidence was challenged by the defendants. Nevertheless, DW1 during cross-examination accepted that there are photos of the artwork as early as the year 2000. This is evidence that the plaintiff was the first to use the artwork;

(3) the above evidence was further corroborated by the testimony of PW2, Lim Lee Kock who testified that he joined Gold Pouch in 2011. When he first joined Gold Pouch, it had only one product — 'Cai Shen Jin Yu Mi'. This product was created by the plaintiff and sold through Gold Pouch; and

(4) the defendants have led evidence that their business only commenced in September 2013 that is, approximately 13 years after the plaintiff first introduced his product to the public.

(b) The defendants' submission

(i) the defendants submit that in determining whether there is an infringement of trademark, the plaintiff will have the onus to prove that the infringing mark is identical or so nearly resembling it as is likely to deceive or cause confusion as envisaged in s 38(1) of the Trade Mark Act 1976;

(ii) the test and factors to be determined in order to establish the likelihood of confusion element has been reflected in the case of *Rotta Research Laboratorium SPA & Anor v Ho Tack Sien & Ors (Chai Yuet Ying, third party)* [2015] 4 MLJevi 222; [2011] 6 MLRH 584 where the court held that:

The test for comparison of confusingly similar marks is not to compare them side by side but to take all circumstances into account. The test is an objective one and the court has to consider the general impression or the basic idea that the mark creates in the mind of the consumer. It is not sufficient for the court just to consider the sound and look of the two opposing marks but to also consider all surrounding factors and features.

The defendants submit that the plaintiff's mark and defendants' mark were not in any way being identical or similar in nature as what has been confirmed via physical comparison of the two products and the statement from the defendants' witnesses during the full trial.

For the ease of reference, the defendants attach herewith the following schedule to highlight the differences between the plaintiff's and defendants' mark:

Particulars	Plaintiff's Product	Defendants' Products
Name	Chai Shen Jin Yu Mi (written in Chinese Character)	Chai Shen Zhao Cai Jin Yu Mi (written in Chinese character)
Main Color	Red	Yellow
Number of character	7	5
Etcetera	Plaintiff's different symbol, arrangement, positioning, posture, font were used	Defendant's different symbol, arrangement, positioning, posture, font were used (as explained by DW-1)
Special design	No side line and price mark	Side line along the box with printed price mark. There is one defendant's logo which was duly registered was also printed at the outset of the products. 'Men-Shen' character appeared at the side of the box

The defendants told the court that the PW1, after being referred to both plaintiff's and defendants' products, had also agreed that there were many differences between the plaintiff's and defendants' products.

In view of the series of differences above, the defendants could not be said to have committed the infringement of plaintiff's mark as is reflected in *Tohtonku Sdn Bhd v Superrace (M) Sdn Bhd* [1992] 2 MLJ 63; [1992] 1 MLRA 350;

(iii) the defendant submits that 'In considering whether there would be confusion and deception to the public by the existence of two allegedly similar trademarks, it is necessary, at the outset, to state that similarity per se is acceptable, so long as it does not lead to a likelihood of confusion or deception'.

'A possibility of confusion is not sufficient. There must be 'a real tangible danger of confusion'.': see *Bata Ltd v Sim Ah Ba @ Sim Teng Khor & Ors (trading as Kheng Aik Trading)* [2006] 6 MLJ 445; [2006] 1 MLRA 762, Court of Appeal;

(iv) the defendants further submit that 'for the purpose of determining similarity, one must look at the mark and sign as a whole'. It is not right to take a part of the word and compare it with a part of the other word; one word must be considered as a whole: *Brg Brilliant Rubber Goods (M) Sdn Bhd v Santa Barbara Polo & Racquet Club Management Inc (Pendaftar Cap Dagang Malaysia, pihak berkepentingan)* [2015] 1 MLRHU 1.

The defendants point out that the plaintiff had relied heavily that the pronunciation and sounds of the plaintiff's product and defendants' products are almost the same. However the defendants submit that the name of the plaintiff's and defendants' products must be read as a whole and not to choose only towards the certain extent: see *Meidi-Ya Co Ltd, Japan & Anor v Meidi (M) Sdn Bhd* [2009] 2 MLJ 14; [2008] 3 MLRA 80;

(v) in view of the above, if the name of defendants' product was to be read as a whole, there will be huge differences particularly in syllable, sounds and number of words as compared with the name of the plaintiff's product. In fact, the Chinese characters as reflected in the product shall be obvious to the Chinese customers who bought the products accordingly;

(vi) the defendants further submit that the only similarity in the name of the product is the words 'Chai-Shen' and that alone would not automatically render the infringement on part of the defendant: see *Rotta Research Laboratorium SPA & Anor v Ho Tack Sien & Ors (Chai Yuet Ying, third party)*;

(vii) the defendants further submit that the words 'Chai Shen' are not invented by the plaintiff. Chai Shen is a very common and popular god in the Chinese culture. It can be easily seen in a lot of the religious products and goods which are related to the Chinese culture and the plaintiff has therefore no right to estop the defendants from using the said words;

(viii) the defendants submit that since it is a common use by the customers to call the product as 'Jin Yu Mi' the use of the words 'Jin Yu Mi' per se is not sufficient to constitute infringement by applying the above test 'one word must be consider as a whole' since the plaintiff's product is called 'Chai Shen Jin Yu Mi' as a whole while the defendants' product is called 'Cai Shen Zao Cai Jin Yu Mi' as a whole. If we look at the meaning by the wording itself, both products have a different meaning:

(1) Cai Sen Jin Yu Mi (plaintiff's product) = Cai Shen (The God of Fortune) Jin Yu Mi (Golden Rice of Fortune); and

(2) Cai Shen Zao Cai Jin Yu Mi (defendants' product) = Cai Shen (The God of Fortune) Zao Cai (bring fortune) Jin Yu Mi (Golden Rice of Fortune).

(ix) be that as it may, since the characters 'Cai Shen' is commonly used by the public at large, the customers will tend to pay more attention to the other mark on both products to distinguish them by those other features. As such, there will be no room for confusion and deception etc. The same also applies to the other daily products and goods of the people at large for example 'colgate' and 'darlie' are brands of toothpaste in which each company does not have the exclusive right over the word 'toothpaste' since the word 'toothpaste' is a common word and is to bring the meaning to the item itself. In our case here 'Jin Yu Mi' is the product itself while 'Cai Shen' is the name of the God.

Therefore, the defendants submit that the claim on infringement over the common name used by the people at large shall not be allowed as this may open a flood gate and further cause confusion to the public at large. Furthermore the words in the first place were not even invented by the plaintiff to give the plaintiff an exclusive right over them.

(c) Ruling of the court

(i) The law

(1) in determining whether a registered trademark is infringed by a person who uses a mark which is identical with it or so

nearly resembling it as is likely to deceive or cause confusion in the course of trade as envisaged in s 38(1) of the Trade Marks Act 1976, our courts have applied the general recollection test adopted by the then Lord President Thompson in the case of *Re Sandow Ltd's Application* (1914) 31 RPC 196 in *MI & M Corporation & Anor v A Mohamed Ibrahim* [1964] 3 MLJ 392.

(2) in applying the above mentioned test in considering whether there would be confusion and deception to the public by the existence of two allegedly similar trademarks, I am guided by the general principles laid down by our courts namely:

(A) the marks concerned must be considered as a whole as the true test on the totality of impression given both orally and visually is as to cause mistake, deception or confusion: *Re Bailey's Application* [1935] 52 RPC 136,*Re Broadhead's Application* [1950] 67 RPC 113 and *Saville Perfumery Ltd v June Perfect Ltd and Woolworth & Co Ltd* (1941) 58 RPC 149;

(B) in comparing the two trademarks, it must be also considered whether the marks suggest the same idea or lead to the goods being referred to by the same name

(C) the words of the two trademarks must be judged by their looks and sound: *Re Pianotist Co's Application* [1906] 23 RPC 774, *Re Kidax (Shirts) Ltd's Applications* [1959] RPC 295;

(D) however mere similarity phonetically in one or two words of the marks is not sufficient to make a case of infringement of trademark;

(E) a possibility of confusion is not sufficient but there must be a real tangible danger of confusion: see *Bata Ltd* case; and

(F) the test is an objective one.

(3) the onus is on the plaintiff to prove that the defendant's mark is deceptively similar or will cause confusion. This is a question of fact.

(ii) I have perused the two trademarks tendered in court as exhibits, I find that they are not identical. However the only resemblances in the two marks are as follows:

(1) the use of the pictures the god of fortune, two fairy maidens and some children; and

(2) the use of some same Chinese words to describe their respective products, namely the plaintiff's registered product is called 'Cai Shen Jin Yu Mi' whereas the defendants' infringing product is called 'Cai Shen Chao Cai Jin Yu Mi'.

(iii) however there are some distinctive features of the two respective marks:

(1) the first distinctive feature:

the plaintiff's logo is placed in between two dragons at the top of the artwork. Whereas the defendant's logo is placed at the top left hand corner of the artwork without any dragons;

(2) the second distinctive features:

the background of the get up of the plaintiff's product is predominantly red in colour. Whereas the background of the defendants' product is predominantly yellow in colour;

(3) the third distinctive feature:

the name of the plaintiff's product which consists of five Chinese words that is Cai Shen Jin Yu Mi appears in vertical line on the right of the artwork. Whereas the name of the defendants' product which consists of seven Chinese words that is, Cai Shen Chao Cai Jin Yu Mi appears in horizontal line on top of the artwork besides its logo.

(4) the fourth distinctive feature:

although both the plaintiff's and the defendants' products use the picture of the God of Fortune, two fairy maidens and some children, it is clear that there are distinctive differences in their costumes hairstyle and their positioning.

(iv) in applying the general recollection test whether a consumer who sees the defendant's trademark in the absence the plaintiff's registered trademark and in view only of his general recollection of what the nature of the plaintiff's trademark was, would be liable to be deceived and to think that the defendants' trademark before him is the same as the other, of which he has a general recollection, it is not sufficient for the court to consider the sound and look of the two opposing marks but to also consider all the surrounding factors and features of the two trademarks: see *Rotta's case*.

Applying the general re-collection test on the evidence adduced and the two opposing trademarks tendered in court, I find that the evidence adduced by the plaintiff vide the three consumers (PW4, PW5 and PW6)

to prove likelihood of confusion is insufficient to show that defendants' mark was confusingly similar to that of the plaintiff. The test is an objective one; and

(v) I am of the considered view that the general impression that the plaintiff's mark creates in the mind of a consumer would be: the plaintiff's logo was placed in between two dragons at the top of the artwork of the pictures of the God of Fortune, two fairy maidens and children with the background colour predominantly in red and the name of the product in five Chinese words appearing in vertical line on the right. Whereas the defendants' mark starts with its own logo with the name of their product in seven Chinese words on top of the artwork of the picture of the God of Fortune and two fairy maidens and children with its predominant yellow background.

It is clear from the comparison of the two trademarks, the only feature of the two products which has a possibility to cause confusion to a consumer is the picture of the God of Fortune and the two fairy maidens and the children. But there are distinct differences between the two products in the picture of the God of Fortune and the two maiden fairies and the children in terms of their costumes, hairstyle, the number of children and its background colour.

Hence, I am of the considered view that when a consumer sees the defendants' trademark in the absence of the plaintiff's trademark, he would not be liable to be deceived and to think that the defendant's mark is the same as the plaintiff, of which he has a general re-collection simply because there were some distinctive features in the plaintiff's mark which are absent in the defendants' marks, namely, the plaintiff's logo in between the two dragon, the name of the plaintiff's product in five Chinese words which appears in vertical line on the right side of the artwork and most importantly the predominant red colour background of the plaintiff's mark.

As regards the picture of the God of Fortune and the two Fairy Maidens, I am of the view that the plaintiff could not claim exclusive use of the said picture as such pictures appear commonly in almost all praying materials in the Chinese community. Similarly the words 'Cai Shen' is the name of the God of Fortune who is commonly worshiped by the Chinese community.

I am also of the considered view that 'Jing Yu Mi' is the name of the product which the plaintiffs cannot have an exclusive use.

Last but not least, I rule that it has been established in evidence that the plaintiff was the first to use the name 'Cai Shen Jin Yu Mi' in the market.

DECISION

[15] For the above reasons, I find that the plaintiff has failed to prove the defendant's acts of infringement of the plaintiff's registered trademark and passing off.

DAMAGES

[16] For completeness, I will proceed to decide on damages on the assumption that the defendant was found liable for infringement of plaintiff's registered trademark and passing off. I have noted that the plaintiff is only praying for two items of damages:

(a) aggravated and compensation damages; and

(b) an inquiry as to damages or as the plaintiff's option an account of profit.

[17] Since the plaintiff submits that the plaintiff has suffered damages in terms of loss of sales, the costs of the publication of warning notice, the costs incurred in advertisements and damage due to the plaintiff's goodwill, it is not appropriate for the plaintiff just to show the probability of damages. I would grant the relief for an inquiry as to the damages suffered by the plaintiff on the assumption that the defendants were liable for the infringement and passing off of the plaintiff's registered trademark.

[18] As regards the relief of aggravated and compensation damages, I rule that the plaintiff is deemed to have abandoned this relief since nothing specific has been submitted on this item of damages in the plaintiff's closing submission.

[19] On the whole I find that the plaintiff has failed to prove its claim against the defendants. I dismiss the plaintiff's claim with cost of RM30,000.

Plaintiff's claim dismissed with costs.

Reported by Kanesh Sundram